

REMARKS

The applicants have thoroughly considered the Official Action dated February 27, 2007, and has prepared this Amendment in response thereto. A Petition for Two-Month Extension of Time and petition fee has been filed concurrently. The applicants thank the examiner for identification of claims 47, 48 and 50 as being allowable if rewritten in independent form.

Summary of Amendments

The applicants cancelled claims 36 - 44.

The applicants amended claim 45 to include the limitations of allowable claim 50 and cancelled claim 50.

The applicants added new independent claim 53, which rewrites allowable claim 47 in independent form.

The applicants added new claims 54 – 57, which depend from new claim 53 and include the limitations of original claims 46, 49, 51 and 52.

Claims 1 – 35, 45 – 49 and 51 – 57 are pending in the application.

The following remarks will follow the order set forth in the Office Action.

Claim Objections

Claim 44 was objected to due to an error in its dependency. As the applicants have cancelled claims 36 – 44, this objection has been rendered moot.

Claim Rejections – 35 USC §112

Claims 1 – 44 were rejected under 35 USC§112, first paragraph, based upon the assertion that “the specification, while being enabling for inverting an image, does not reasonable provide enablement for enhancing the original image using this inversion”. In

support of this rejection, the office action states, “(a)dding an inverted image with the original image would seem to only brighten the original image, not enhance its contrast”. For the reasons set forth below, the applicant respectfully disagrees with this rejection.

In making the rejection under 35 USC§112, first paragraph, the examiner admits that the specification is enabling for inverting an image, but appears to question the efficacy of adding an inverted image with the original image. Therefore, the enablement rejections does not involve a claim of undue experimentation, but rather appears to rest on the belief that the invention will not work as claimed. In response to this rejection, the applicants point to FIGS. 6A – 6B, which demonstrate the efficacy of the present invention.

“FIGS. 6A, 6B and 6C demonstrate the image enhancement produced by the system of the present invention. FIG. 6A is a photograph of a human forearm using light from the visible spectrum. As seen from this photograph, it is difficult to locate the veins upon visual inspection. FIG. 6B is a raw image of the same human forearm sent from the image capture assembly 30 of the present invention to the processing unit. The veins in this image is considerably more visible than those in FIG. 6A. However, they are not sufficiently dark and well defined to allow easy location of the veins during venepuncture. FIG. 6C is an enhanced image using the image enhancement process of the present invention. As can be seen from this figure, the veins are very dark and, therefore, are easily located for venepuncture.” Page 38, lines 4 – 13.

As these drawing figures and the description thereof make clear, the claimed image enhancement process does not merely brighten the image, but enhances it in a manner commensurate with the scope of the claims. Thus, the claimed invention is not a mere proposition of an unproved hypothesis, as was the case in *Rasmusson v SmithKline Beecham Corp.*, 413 F.3d 1318 (Fed. Cir. 2008), in which the claims were found to be non-enabling due to a lack of efficacy. Rather, as shown in FIG. 6C, the claimed

invention is one that works in the efficacious manner in which it was described and is claimed.

For the reasons set forth above, the applicants assert that the rejections under 35 U.S.C. §112, first paragraph, should be withdrawn.

Patentability of Claims 1 – 44

The only explicit rejection of claims 1 – 44 was under 35 U.S.C. §112, first paragraph. However, the “Conclusion” portion of the Office Action appears to make out an obviousness rejection of these claims by stating “(a)s shown in Figure 3, Avinash discloses all of the limitations of claims 1, 20 and 36 except inverting an image.” The applicants do not agree that Avinash includes all of the claimed limitations except the inverting step. However, the applicants have chosen not to present these arguments at this time because the rejection of claims 1 – 44 under 35 U.S.C. §112, first paragraph, based upon the allegation that the inverting step would not produce the claimed result is sufficient proof that it would not be obvious to modify Avinash to obtain the claimed invention. In other words, if the examiner, who is one of at least ordinary skill in the art, would believe that the claimed step of inverting an image would only brighten the image, there would be no motivation to add this step to the teachings of Avinash for the purpose of enhancing images.

Based upon the foregoing, the applicants assert that pending claims 1 – 35 are patentable over Avinash, and the other cited art, and respectfully requests that these claims be reconsidered and allowed in view of the applicant’s arguments.

Claim Rejections – 35 USC §102

Claims 45, 46, 49, 51 and 52 were rejected as anticipated by Flock (US PAT NO. 6032070). In response to these rejections, the applicants amended claim 45 to include the limitations of original claim 50, which the examiner identified as allowable. As claims 46, 49, 51 and 52 depend from amended claim 45, the applicants assert that the rejection of claims 45, 46, 49, 51 and 52 have been rendered moot by the applicants' amendment and that claims 45 – 19 and 51 – 52 are allowable. Therefore, the applicants respectfully request that the examiner reconsider the rejections in light of the applicants' amendment and allow claims 45 – 19 and 51 – 52.

New Claims 53 - 57

The applicants added new independent claim 53, which rewrites original claim 47 in independent form. As original claim 47 was identified as being allowable, new claim 53 should likewise be found to be allowable. In addition, the applicant added new claims 54 – 57 that depend from new claim 53. Claims 54 – 57 include the limitations of original claims 46, 49, 51 and 52 and, accordingly each meets the written description requirement and do not add new matter. For these reasons, the applicants assert that new claims 53 – 57 are allowable and respectfully request that the examiner allow these claims.

Conclusion

It is felt that a full and complete response has been made to the Official Action and, as such, places claims 1 – 35, 45 – 49 and 51 – 57 in condition for allowance. Such allowance is hereby respectfully requested. If the examiner feels, for any reason, that a personal interview will expedite the prosecution of this application, he is invited to phone the applicants' attorney at the number set forth below.

Respectfully submitted,



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